

wherein the outsole has a further contraction, the further contraction being arranged on an outer side of the shoe.

BS  
24. (Amended) The shoe according to claim 11,  
wherein the outsole is provided with a heel in the first area.

25. (Amended) The shoe according to claim 17,  
wherein the profiling is made up of at least two materials having different elasticities.

26. (Amended) The shoe according to claim 18,  
wherein the profiling is made up of at least two materials having different elasticities.

Please add new claim 27 as follows:

BY  
27. (New) The shoe according to claim 11,  
wherein the outsole has a connecting area adjacent to the  
contraction configured to minimize torsion of a forefoot with respect to the back of the foot.

### REMARKS

#### **I. Introduction**

With the addition of claim 27, claims 11 to 27 are pending in the present application. In view of the following amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested. The claims have been renumbered as requested by the Examiner.

Applicants note with appreciation the acknowledgment for the claim for foreign priority and the indication that all of the certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

## **II. Objection to the Drawings**

The Office Action objected to Figure 3 as failing to comply with 37 CFR §1.84(p)(5) for including reference numbers 11.1, 11.2 and 19 stated not to be in the specification. Applicants herein submit amended red-lined Figure 3 with reference numbers 11.2 and 19 crossed out and 11.1 replaced with reference number 11. No new matter has been added. Reference 11 is already included in Figure 4 and reference is made to it at least on page 7 of the Specification.

## **III. Objection to the Specification**

The Office Action objected to the Abstract for containing more than one paragraph. Applicants submit that the Specification, as amended, overcomes the objection. Accordingly, withdrawal of the objection is respectfully requested.

## **IV. Rejection of claims 14, 16 and 23 under 35 U.S.C. §112**

Claims 14, 16 and 23 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

Claims 14, 16 and 23 have been canceled thus rendering the rejection of these claims moot.

## **V. Rejection of claims 11-26 under 35 U.S.C. §103(a)**

### **A. Rejection of claims 11-14, 16 and 20-24**

The Examiner rejected claims 11-14, 16 and 20-24 under 35 U.S.C. §103(a) as being unpatentable over French reference to Decathlon Production 560,698 ("Decathlon") in view of U.S. Patent No. 4,878,301, issued to Kiyosawa ("Kiyosawa"). Claim 11 has been amended to correct a typographical error but otherwise is unchanged.

The Examiner alleges that Decathlon discloses all the limitations of claims 11-14, 16 and 20-24 except for a heel guide having a heel plate. Office Action page 2, paragraph 7. The Examiner further alleges that Kiyosawa teaches that a shoe can have a heel counter attached to it to aid in supporting the heel of a user. The Examiner concludes that it would have been obvious to make the heel counter of Decathlon out of a hard elastic heel plate, as purportedly taught by

Kiyosawa, to aid in balancing the heel of the user during use to aid in preventing pronation or supination.

Kiyosawa recites a sports shoe stated to be provided with an upper 20, a shoe sole 21 and a heel counter 22. Col. 2, lines 67-68 and Col. 3, lines 1-2. The heel counter 22 is stated to comprise a heel side wall shaped with a curve along an under heel part of a shoe and is nipped between the upper 20 and shoe sole 21. Kiyosawa Abstract. A lower surface of the heel counter under the heel part is stated to be provided with a plurality of recesses. Col. 4, lines 13-19.

Claims 11-14, 16 and 20-24 require a heel guide provided in the upper part. This is in contrast to Kiyosawa, whose heel counter 22 is stated specifically to be nipped between the upper 20 and the shoe sole 21 and to curve under the heel part of the shoe.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As established above, neither Decathlon or Kiyosawa disclose, or even suggest, all of the limitations of claims 11-14, 16 and 20-24. Specifically, Kiyosawa does not disclose a heel guide in the upper part of a shoe. Nor is there any suggestion or motivation to modify or combine the disclosures of Decathlon and Kiyosawa in the manner contemplated by claims 11-14, 16 and 20-24. Simply stating that a shoe can have a heel counter attached to it to aid in supporting the heel of a user does not render it obvious to combine a heel counter with a shoe specifically designed to promote a heel-to-toe motion of a foot, comprising an outsole having a contraction extending to a first area where a back of the foot is located.

The Examiner should not use the claims as an instruction manual to find appropriate prior art that might render the claims obvious. As stated by the Federal Circuit, the actual determination of the issue of obviousness requires an evaluation of the *claimed invention as a whole*, not merely the differences between the claimed invention and the prior art.

*Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025, 1033

(Fed Cir. 1984)(emphasis added). As stated on page 3 of the present specification, it is the combination of an increased rotational mobility in the heel part of the sole with respect to the forward part of the sole, together with a zone of high flexibility in the ball of the foot area of the front of the foot that promotes the physiological heel to toe motion of the foot. Accordingly, even if

Kiyosawa did disclose a heel guard in the upper part (which, as detailed above, it does not) it would not have been obvious that a heel counter in the upper part, as required by claim 11-14, 16 and 20-24, would work well with the rest of the shoe as claimed in claims 11-14, 16 and 20-24, i.e., still provide for a desired heel to toe motion of the foot.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of amended claims 11-14, 16 and 20-24. It is therefore respectfully submitted that amended claims 11-14, 16 and 20-24 are allowable for these reasons.

### **B. Rejection of claims 15, 17, 19 and 25**

The Examiner rejected claims 15, 17, 19 and 25 under 35 U.S.C. 103(a) as being unpatentable over the Decathlon and Kiyosawa references, as applied to claim 11, in view of U.S. Patent No. 5,024,007, issued to DuFour ("DuFour").

The Office Action alleges that Decathlon and Kiyosawa disclose all the limitations of claims 15, 17, 19 and 25 except for the outsole having profiling for a greater flexibility of the outsole with regard to the heel-to-toe motion of the foot and having one of a parallel grooves and ray-shaped grooves, the grooves extending at least partially over a width of the shoe, and the profiling being made up of at least two materials having different elasticity. See Office Action at page 3, paragraph 8. The Office Action further alleges that DuFour teaches that the forefoot area of the sole of a shoe can have profiling made up of grooves and material filled within the grooves to aid in flexibility and gripping of the sole to the contact surface. The Office Action further alleges that DuFour teaches that the grooves can be parallel (Figure 1) and extend at least partially over a width of the sole of the shoe and made up of two materials (A and B), the materials having a different elasticity (col. 2, lines 56-68). The Examiner concludes that it would have been obvious to make a profile, as purportedly shown in DuFour, on the sole of the shoes in Decathlon and Kiyosawa, to aid in making the sole flexible as well as still allowing grip. Applicants respectfully disagree.

Given the ultimate dependence of claims 15, 17, 19 and 25 on claim 11, Applicants respectfully reassert the arguments made above in reference to the rejection of claims 11-14, 16 and 20-24. As stated above, to establish prima facie obviousness, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is respectfully submitted that DuFour does not remedy the Decathlon defect,

i.e., it does not disclose a heel guide provided in the upper part of the shoe, as required by all of the claims. Furthermore, with respect to at least claim 17, DuFour does not disclose profiling having one of parallel grooves and ray-shape grooves. The walking sole of DuFour comprises notches 2 not grooves, as recited by claim 17.

According to *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987)(emphasis added), obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, *absent some teaching, suggestion or incentive* supporting the combination. The mere fact that references *can* be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the *desirability* of the combination. *In re Kartzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Absent such a showing in the prior art, the Examiner has impermissibly used “hindsight” by using applicants’ teaching as a blueprint to hunt through the prior art for the claimed elements and combine them as claimed. *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Since, in the present case, DuFour fails to suggest the desirability of combining notches 2 with a shoe specifically designed to promote a heel-to-toe motion of a foot, comprising an outsole having a contraction extending to a first area where a back of the foot is located, as required by claims 15, 17, 19 and 25, Applicants respectfully submit that the Examiner’s assertion that “it would have been obvious to ... make a profile, such as that shown in DuFour ‘007, on the sole of the references as applied to claim 11 above to aid in making the sole flexible as well as still allowing grip” is based on impermissible hindsight. Accordingly, claims 15, 17, 19 and 25 are in allowable condition. Therefore, the rejection of claims 15, 17, 19 and 25 under 35 U.S.C. § 103(a) in view of the Decathlon, Kiyosawa and DuFour references should be withdrawn.

### **C. Rejection of claims 18 and 26**

Claims 18 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Decathlon, Kiyosawa and DuFour references, as applied to claim 17, in view of the French reference to Scop Minibel Sa Societe Anonyme 2,739,533 (“Scop”).

The Office Action alleges that the references as applied to claim 17 disclose all of the limitations of the claims except for the grooves extending over the entire width of the shoe. The Office Action further alleges that Scop teaches that grooves 5 made in the forefoot of the shoe for

flexibility of the sole can extend the entire width of the shoe to allow the sole to flex with the normal flexing of the user's foot. The Office Action concludes that it would have been obvious to make the grooves of the references as applied to claim 17 across the entire shoe to aid in flexing the sole with the normal flexing of the user's foot. See Office Action at page 4. Applicants respectfully disagree.

Given the dependence of claims 18 and 26 on claim 17 and their ultimate dependence on claim 11, Applicants respectfully reassert the arguments made above in reference to the rejection of claims 11-14, 16 and 20-24 and 15, 17, 19 and 25. As stated above, to establish prima facie obviousness, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is respectfully submitted that Scop does not remedy the Decathlon defect, i.e., it does not disclose a heel guide provided in the upper part of the shoe, as required by all of the claims. Therefore, it is respectfully requested that the rejection of claims 18 and 26 under 35 U.S.C. § 103(a) in view of the Decathlon, Kiyosawa, DuFour and Scop references be withdrawn.

#### **VI. New Claim 27**

New claim 27 has been added herein. It is respectfully submitted that new claim 27 does not add any new matter and is fully supported by the present application, including the Specification. It is respectfully submitted that claim 27 is allowable.

**VII. Conclusion**

Attached hereto is a marked-up version of the changes made to the Specification and claims by the current Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: April 18, 2003

By:



Abraham Ronai  
Reg. No. 41,275

One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**



**26646**

PATENT TRADEMARK OFFICE

Version with Markings to Show Changes Made

**IN THE SPECIFICATION:**

The section captioned "ABSTRACT OF THE DISCLOSURE" has been amended as follows:

An improved shoe, promoting a heel-to-toe motion of a foot, comprising an outsole and an upper part. The outsole has a contraction extending to a first area where a back of the foot is located. The upper part has a heel guide, including one of a heelplate and a flexible heel brace, which are arranged in a second area where the heel of the foot is located, such that an Achilles tendon of the foot is free.

[A shoe, having an outsole and an upper part that is connected thereto, the outsole in the area between the forefoot and the back of the foot having a contraction, does not of its own accord sufficiently promote the natural rolling motion of the foot when the foot is in motion and when the child takes its first steps.

The outsole in the area of the contraction has a connecting area having a degree of flexibility such that a torsion of the forefoot with respect to the back of the foot is impeded as little is possible, and that, in the area of the forefoot, the outsole is provided with a high degree of flexibility with respect to the motion of the foot as a result of a corresponding profiling. Thus the natural motion of the child's foot can be maintained, while simultaneously providing sufficient protection for the child's foot during walking.]

**IN THE CLAIMS:**

The claims have been amended as follows:

11 [12]. (Amended) A shoe for promoting a heel-to-toe motion of a foot, the shoe comprising:

an outsole;

an upper part;

wherein the outsole has a contraction, the contraction extending to a first area where a back of the foot is located;

wherein a heel guide for a heel of the foot is provided in the upper part, the heel guide having one of a heelplate and a flexible heel brace;

wherein the one of the heelplate and the flexible heel brace are arranged in a second area where the heel of the foot is located;

wherein the one of the heelplate and the flexible heel brace are such that an [a] Achilles tendon of the foot is free.

**Serial No. 09/890,706**

**Version with Markings to Show Changes Made**

12 [13]. (Amended) The shoe according to claim 11 [12],

wherein the contraction in the outsole is in a third area between where a forefoot of the foot is located and where the back of the foot is located;

13 [14]. (Amended) The shoe according to claim 11 [12],

wherein, the outsole has a connecting area adjacent to the contraction.

15 [16]. (Amended) The shoe according to claim 11 [12],

wherein, in a fourth area where a forefoot is located, the outsole has a profiling, the profiling providing for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot.

17 [18]. (Amended) The shoe according to claim 15 [16],

wherein the profiling has one of parallel grooves and ray-shaped grooves, the one of the parallel grooves and the ray-shaped grooves extending at least partially over a width of the shoe.

18 [19]. (Amended) The shoe according to claim 17 [18],

wherein the one of the parallel grooves and the ray-shaped grooves extend over the entire width of the shoe.

19 [20]. (Amended) The shoe according to claim 15 [16],

wherein the profiling is made up of at least two materials having different elasticities.

20 [21]. (Amended) The shoe according to claim 11 [12],

wherein the contraction of the outsole is arranged on an inner side of the shoe.

21 [22]. (Amended) The shoe according to claim 11 [12],

wherein the contraction of the outsole is arranged on an outer side of the shoe.

**Serial No. 09/890,706**

**Version with Markings to Show Changes Made**

22 [23]. (Amended) The shoe according to claim 20 [21],

wherein the outsole has a further contraction, the further contraction being arranged on an outer side of the shoe.

24 [25]. (Amended) The shoe according to claim 11 [12],

wherein the outsole is provided with a heel in the first area.

25 [26]. (Amended) The shoe according to claim 17 [18],

wherein the profiling is made up of at least two materials having different elasticities.

26 [27]. (Amended) The shoe according to claim 18 [19],

wherein the profiling is made up of at least two materials having different elasticities.

New claim 27 has been added as follows:

27. (New) The shoe according to claim 11,

wherein the outsole has a connecting area adjacent to the contraction configured to minimize torsion of a forefoot with respect to the back of the foot.